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REMARKS

Applicants' attorney would like to thank the Examiner for careful consideration of this Application. Claims 1-19 are pending in the application. Claims 1-12 have been amended. Claims 13-19 have been added. Support for all amendments can be found in the specification as originally filed.

Objections to the Specification

The title stands rejected to as not being descriptive. Applicants have amended the title to: "Filled Elastomeric Compounds and Methods for Preparing Same" thereby attending to the Examiner's objection. Withdrawal of the Examiner's objection is respectfully requested.

The Abstract stands objected to for containing the line "compared to analogous compounds...". The Abstract has been amended to remove the objected to line thereby attending to the Examiner's objection. Withdrawal of the Examiner's objection is respectfully requested.

Claim Objections

Claims 2-10 stand objected because these claims contain the phrase "A process according to...". This phrase has been amended to "The process..." thereby attending to the Examiner's objection. Withdrawal of the Examiner's objection is respectfully requested.

Double Patenting

Claims 1, 5, and 8 stand rejected for nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-6 of U.S. Patent No. 6,992,122.

A terminal disclaimer is concurrently submitted herewith rendering the Examiner's rejection moot.

Double Patenting, II and Rejections over U.S. Patent No. 7,015,265

Claims 1 and 8 stand rejected for nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-11 of U.S. Patent No. 7,015,265 to Resendes et al. (hereinafter "Resendes '265"), and Claims 1 and 8 stand rejected under 35 U.S.C. 103(a) as being obvious over and Claims 1-10 and 12 stand rejected under 35 U.S.C. 102(e) as being anticipated by Resendes '265.

Applicants respectfully submit that the pending application and Resendes '265 are commonly owned and that the inventors in the pending application are the prior inventors under 35 U.S.C. 104. Therefore, Resendes '265 is not available to the Examiner as prior art. Applicants have respectfully submitted herewith a Declaration under 37 CFR 1.130 indicating that the pending application and Resendes '265 are commonly owned by Lanxess, Inc. and a Terminal Disclaimer under 37 CFR 1.321(c). Accordingly, Resendes '265 is disqualified as prior art (See MPEP 718). Withdrawal of the Examiner's rejections is respectfully requested.

Rejections under 35 U.S.C. 103

Claims 1-10 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2002/0156173 to Hopkins et al. (hereinafter "Hopkins") and Claims 1-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,706,804 to Resendes (hereinafter "Resendes '804").

The Examiner alleges that Hopkins and Resendes '804 teach a process which includes mixing a halobutyl elastomer with a mineral filler in the presence of an additive which may be an organic compound having at least one hydroxyl and at least one nitrogen-containing group and contends that it would have been obvious to combine these components in any order. Applicants respectfully disagree.

It is well settled that to establish a *prima facie* case of obviousness, the USPTO must satisfy all of the following requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to

modify a reference or to combine references. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Clr. 1988). Second, the proposed modification must have a reasonable expectation of success, as determined from the vantage point of one of ordinary skill in the art at the time the invention was made. *Amgen v. Chugai Pharmaceutical Co.* 18 USPQ 2d 1016, 1023 (Fed Clr, 1991), *cert. denied* 502 U.S. 856 (1991). Third, the prior art reference or combination of references must teach or suggest all of the limitations of the Claims. *In re Wilson*, 165 USPQ 494, 496, (CCPA 1970).

Neither Hopkins nor Resendes '804 teach or suggest all of the steps recited in amended independent Claims 1 and 12, and fail to teach or suggest a prereacted filler material prepared by the step of reacting the mineral filler with an organic compound having at least one hydroxyl and at least one nitrogen-containing group as recited in amended independent Claims 1 and 12. Applicants submit that amended independent Claims 1 and 12 go beyond simply changing the order of mixing of the recited components because the filler and the organic compound are reacted to make a prereacted filler prior to the addition of the elastomer. Accordingly, Hopkins and Resendes '804 fail to teach or suggest the step reacting the filler with the organic compound of the process of amended independent Claim 1, and fail to render amended independent Claim 1 obvious.

Moreover, Hopkins and Resendes '804 fail to teach or suggest a prereacted filler as recited in amended independent Claims 1 and 12 because Hopkins and Resendes '804 fail to teach or suggest reacting the filler and the organic compound prior to the addition of the elastomer. According to the teaching of Hopkins and Resendes '804, the elastomer and filler react with the organic compound simultaneously regardless of the order in which the components are combined. Therefore, a prereacted filler is never formed. Accordingly, these references fail to teach or suggest all of the limitations of amended independent Claims 1 and 12, and fail to render amended independent Claims 1 and 12 obvious.

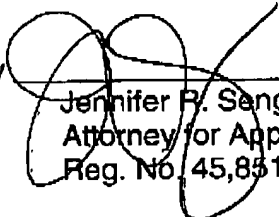
Additionally, Hopkins and Resendes '804 fail to provide a reasonable expectation of successfully preparing a filled elastomer as recited in amended independent Claims 1 and 12. In particular, as alluded to by the Examiner, Hopkins

and Resendes '804 teach that the at least one hydroxyl and at least one nitrogen-containing group react with both the filler and the active halogen of the halogenated butyl elastomer. Applicants submit that allowing the organic compound to first react with the filler would be expected to limit the ability of the organic compound to react with the elastomer because many of the reactive groups would have reacted with the filler prior to the addition of the elastomer and would not be available to react with the elastomer. Therefore, prereacting the filler with the organic compound would be expected to have a deleterious effect on the properties of the filled elastomer. Applicants show that this is not the case. Accordingly, Hopkins fails to provide a reasonable expectation of successfully preparing a filled halobutyl elastomer by first making a prereacted filler as recited in amended independent Claims 1 and 12.

Accordingly, Hopkins fails to render amended independent Claims 1 and 12 obvious. Claims 2-10 either directly or indirectly depend from and add further limitations to amended independent Claim 1, and are respectfully deemed allowable at least for the same reasons in connection with amended independent Claim 1. Reconsideration and withdrawal of the Examiner's rejections are respectfully requested.

Applicants submit that the pending claims are in condition for allowance and notice to such effect is respectfully requested. Should the Examiner have any questions regarding this application, the Examiner is invited to initiate a telephone conference with the undersigned.

Respectfully submitted,

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